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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,254	11/01/2000	Blaine Garst	19004-009002	3557
26183 7590 01/25/2008 FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
EXAMINER				
GREENE, DANIEL LAWSON				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
01/25/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/704,254

Applicant(s)

GARST ET AL.

Examiner

DANIEL L. GREENE

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/31/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-86, 88-92 and 94-147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-86, 88-92 and 94-147 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
Paper No(s)/Mail Date: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/2007 has been entered.

2. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

Response to Arguments

3. Applicant's arguments filed 10/31/2007 have been fully considered but they are not persuasive.

Applicant argues:

"Applicants respectfully submit that the Examiner's new rejections are improper in that the Examiner's rejections are based on mere conclusory statements without any articulated reasoning or rational underpinning to support the legal conclusion of obviousness."

"In paragraph 4 of the Final Office Action, the Examiner argues that Applicants' claimed authorization indicator provides a "benefit of allowing the software to be installed and used on an isolated computer, i.e., one that does not have connection to the internet or other communication connections in order to verify authorization."

"Applying the logic of the court's question to this application, the proper question is whether Wyman or Ross (both of which are designers of ordinary skill) would have seen a benefit to not connecting to the Internet or other communication connections to verify authorization. Since Wyman and Ross teach a network-based license verification solution, **Wyman and Ross would not have seen a benefit to non-networked-based license verification solution**, since a non- networked-based license verification solution would not have worked in a distributed computing system." (Emphasis added)

Response:

It is considered that the Examiner did provide "articulated reasoning or rational underpinning to support the legal conclusion of obviousness" as evidenced, for example, by the statement from page 4 of the previous Office action mailed 9/6/2007 wherein the Examiner stated:

"In the instant case it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Wyman by integrating the access authorization indicator into the software program itself **for the benefit of allowing the software to be installed and used on an isolated computer, i.e. one that does not have connection to the internet or other communication connections in order to verify authorization.**" (Emphasis added)

By reading this statement it appears obvious on its face that the reason and rational supporting the conclusion of obvious can be found in the phrase "allowing the software to be installed and used on an isolated computer, i.e. one that does not have connection to the internet or other communication connections in order to verify authorization."

Applicant states "Wyman and Ross would not have seen a benefit to non-networked-based license verification solution"

For arguments sake, even If Wyman and Ross would not have seen a benefit to non-networked-based license verification solution, one of ordinary skill in the art would have. Support for the Examiners contention that there is indeed a market (and therefore motivation) for isolated computers to have an access authorization indicator allowing software programs to access software resources can be found in, for example, the 1997 and 2003 Census reports wherein it is disclosed:

Table C of the 1997 Census report shows 79,594,000 people had computers but only 35.2% used the internet at home. Therefore one can deduce that 74.8% of the people did NOT use the internet. $74.8\% \text{ of } 79,594,000 = 59,536,312$. Therefore nearly 60 million people had computers that were NOT connected to a network.

The passage of time did NOT alleviate the fact that there are still MILLIONS of computers NOT connected to the internet. See for example page 3, third column of the Computer and Internet Use in the United States: 2003 Census report

Households Without Internet Access

Forty-five percent of households did not have Internet access at home in 2003.⁶ The three most common reasons were "don't need it, not interested" (39 percent), "costs are too high," and "no computer or computer inadequate" (each at 23 percent, Table B). A few households had "access elsewhere" (2 percent). "Language barriers," "concern that children will access inappropriate sites," and "privacy and security concerns" were rarely given as reasons (each 1 percent).⁷

see also Table B on said page 3 where 51,274,000 households
STILL did NOT have internet access.

Clearly the Census reports indicate a market (and therefore motivation) for non-networked computers that would need to have complete access of the entire program locally without the need for connecting to a network for authorization.

Further, during the evolution process of computers and computer software there was software called freeware, shareware, ect. where you could get software with limited functions, but you had to call a number and pay money to get the code that unlocked the rest of the game. This allowed people to try before they buy.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel L Greene Jr./
Examiner, Art Unit 3694
2008-01-22

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694